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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,430	11/06/2000	Paul J. Cornay	5770.04	1466

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INTELLECTUAL PROPERTY DEPARTMENT
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DENVER, CO 80202-5647

EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/05/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/707,430

Applicant(s)
Cornay

Examiner
Charles Cooley

Art Unit
1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 27 Aug 2002

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 4-6 and 13-17 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 4-6 and 13-17 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☒ The proposed drawing correction filed on 29 May 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 15

6) ☐ Other:

Art Unit: 1723

OFFICE ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 28 MAY 2002 (prior to the Advisory Action) and 27 AUG 2002 (filed with the RCE) have been entered.

Information Disclosure Statement

2. Note the attached PTO-1449 form submitted with the Information Disclosure Statement filed 27 AUG 2002 (based upon the European Search Report of 21 DEC 2001).

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 29 MAY 2001 have been approved by the Examiner.

Art Unit: 1723

Specification

4. The abstract is acceptable.
5. The title is acceptable.
6. ~~The disclosure is objected to because of the following informalities:~~

a. In the "CROSS-REFERENCE TO RELATED APPLICATIONS--" section of the specification (see page 2 of the amendment filed 29 MAY 2001), line 3: replace "claims the benefit" with --is a continuation-- as Serial No. 09/298,272 is a continuation of Serial No. 08/950,377. The printer requires specific information on how the applications are related rather than the more general "claims the benefit of" which will invoke an unwanted printer query at allowance.

Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1723

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 13, 15, 16, and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 11, and 12 of U.S. Patent No. 5,944,648 to Cornay. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are anticipated by the patented claims. See *In re Goodman*, supra.

Claim Rejections - 35 U.S.C. § 112

9. Claims 4-6 and 13-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Upon reconsideration, claim 13 is vague and incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The structural cooperative relationship between the "concentrically innermost tube" and the elements of claim 16 is lacking. Since claim 16 is silent with respect to any tubes, it is unclear what structure in claim 16 cooperates with the "concentrically innermost tube" such that this tube is disposed concentrically innermost. Furthermore, the recitation of

Art Unit: 1723

"concentrically innermost tube" infers a plurality of tubes (would not multiple tubes have to be present for one to be the concentrically innermost tube?) yet the claims are silent with regard to a plurality of tubes. Claim 13 is therefore confusing and of indeterminate scope when examined in light of claim 16 (from which it now depends).

Claim 15, line 8: the recitation of "one or more tube walls" inferentially sets forth the tube walls and/or tubes which form the walls. Accordingly, it is unclear what structure is being recited that actually defines the "one or more tube walls" rendering the claim indefinite. For contrast, note the manner in which the tubes and the walls of the tubes were properly defined in the amendment to claim 3 appearing in the response filed 03 OCT 2001. In line 11, "said heavier materials" lacks antecedent basis - change to --said heavier material--.

Claim 16, line 12: does "a mixture of initial material" have any relationship to the "mixture of initial material" recited in the preamble?

Claim 17: "said heavier materials" lacks antecedent basis - change to --said heavier material--.

Art Unit: 1723

Claim Rejections - 35 U.S.C. § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 4-5, 13, 14, and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nerad (USP 3,150,944).

The patent to Nerad (USP 3,150,944) discloses a centrifuge comprising a housing 7 having a central body (above 13) with a top and bottom collar (the areas above and below 27); the central body defining an axis; a hollow arm 23 extending from the central body with a first end attached to the central body and a second end extending away from the central body (Figs. 1-2); the hollow arm 23 defining a chamber therein; a baffle 22 attached to the central body and extending into the chamber of the hollow arm 23; the baffle 22 defining flow paths between tube walls (one path being within the baffle 22 and another being between the outer portion of the baffle 22 and the inner portion of the arm 23); a frame 12, 17 supporting the housing 10 for rotation of the arm; and a bearing 14 engaging the top collar (above 27); a concentrically innermost tube 13; and an outlet channel 28.

12. Claims 13-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Strezynski (USP 2,185,279).

Art Unit: 1723

The patent to Strezynski (USP 2,185,279) discloses a centrifuge (Figs. 8-10) comprising a housing (Figs. 8 and 10) having a central body 10; the central body 10 defining an axis; a hollow arm 11, 12, 13, 14, 15, or 16 and 20 extending from the central body with a first end attached to the central body and a second end extending away from the central body (Fig. 8); the hollow arm 11, 12, 13, 14, 15, or 16 each defining a chamber therein (Fig. 8); a baffle 40 attached to the central body and extending into the chamber of the hollow arm; the baffle 40 defining flow paths between tube walls (one path being within the baffle 40 and another being between the outer portion of the baffle 40 and the inner portion of the arm 11, 12, 13, 14, 15, or 16); means 30, 31 for removing heavier material from the housing; outlet channel 22, 28, or 38; and a concentrically innermost tube 25.

* * *

With regard to the above rejections, the operational and functional language of claim 14 has been considered but is deemed but a method of operation of an apparatus which fails to impart or invoke any means or structure to the *apparatus* claims which defines over the applied prior art.

With regard to the claim limitations, all that is recited is multiple paths and an outlet channel which is met by the prior art. The function of the paths does not further limit the paths and is merely tantamount to an intended use of the paths. Such an intended use has not been afforded any patentable weight because it has been held

Art Unit: 1723

that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527; *In re Lemin et al.*, 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641.

Claim Rejections - 35 U.S.C. § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerad (USP 3,150,944) in view of Coleman (USP 1,510,657).

Nerad (USP 3,150,944) discloses a drive motor 16 for providing rotational motion but does not disclose the recited ring gear. Coleman (USP 1,510,657) discloses a drive means for a centrifuge comprising a drive motor 29 and a ring gear 26 coupled to housing 14 and the motor 29. In view of the teachings of Nerad which suggests that any suitable means for rotating the centrifuge may be employed (Col. 2, lines 16-19), it

Art Unit: 1723

would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the centrifuge of Nerad with a motor and ring gear drive means as disclosed by Coleman for the purpose of providing a simple and efficient means for imparting motion to the centrifuge (Col. 1, lines 18-20).

Allowable Subject Matter

15. In view of the rejections over Nerad and application of the relevant art cited in the European Search Report, no claims stand allowed.

Response to Amendment

16. Applicant's arguments with respect to the pending claims have been considered but are deemed to be moot in view of the new grounds of rejection. This is a non-final office action.

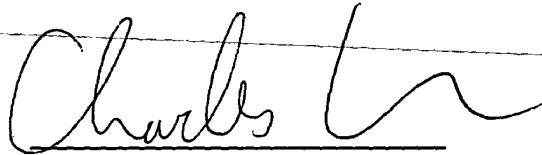
Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is ☎ (703) 308-0112.

Art Unit: 1723

18. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is ☐ (703) 308-0651.

Dated: 4 September 2002

A handwritten signature in cursive script, appearing to read "Charles Cooley", written over a horizontal line.

Charles Cooley
Primary Examiner
Art Unit 1723